

OP 1646



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of )

PETER KUSHNER, ROSALIE M. UHT and )  
PAUL WEBB )

Serial No.: 09/103,355 )

Filed: June 23, 1998 )

For: METHODS FOR SCREENING )  
NULCLEAR TRANSCRIPTION )  
FACTORS FOR THE ABILITY TO )  
MODULATE AN ESTROGEN )  
RESPONSE )

Group Art Unit: 1646

Examiner:  
M. Pak

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JAN 31 2000

San Francisco, California

Assistant Commissioner for Patents  
Washington, D.C. 20231

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Assistant Commissioner for Patents, Washington, D.C. 20231 on January 12, 2000.

Sandy Ellsworth

*Sandy Ellsworth*  
Signature

1/12/00  
Date

RESPONSE TRANSMITTAL

Sir:

Transmitted herewith is a response in the captioned application.

No additional fee is required.

A 2-month extension of time in which to respond to the outstanding Office action is hereby requested and a check in the amount of \$190 is enclosed to cover the fee.

The Commissioner is hereby authorized to charge any additional fees which may be required, or credit any overpayment, to Deposit Account No. 13-1030. A duplicate copy of this sheet is enclosed.

Respectfully submitted,



Dated: January 12, 2000.

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Tom Hunter (Reg. No. 38,498)  
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Atty. Docket: 2500.132US1

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

PETER KUSHNER, ROSALIE M. UHT,  
and PAUL WEBB,

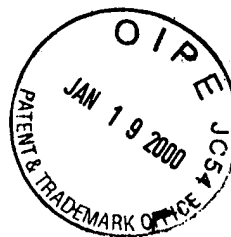
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Name: SANDY ELLSWORTH  
Sandy Ellsworth 1/12/00  
Signature Date

RESPONSE

Sir:

In response to the Office Action dated October 28, 1999, Applicant respectfully requests reconsideration of the above-identified application in view of the following amendments and remarks. A petition to extend the period of response for two months is enclosed.

In the Office Action dated October 28, 1999, the Examiner required restriction to one of the following groups under 35 U.S.C. §121:

Group I: Claims 1-13, drawn to methods of screening nuclear transcription factor ligands for the ability to modulate estrogen activation at an AP-1 site;

- Group II: Claims 14-24, drawn to methods of screening an agent (*e.g.* a drug candidate) for the ability to alter modulation of estrogen activation at an AP-1 site by a nuclear transcription factor ligand; and
- Group III: Claims 26-28 drawn to kits for screening nuclear transcription factor ligands for the ability to modulate estrogen activation at an AP-1 site.

***In response to this restriction requirement, Applicants provisionally elect Group I, claims 1-13, with traverse.***

Applicants also submit that restriction between Groups I, II, and III is unnecessary. According to MPEP §803, the Examiner should examine all claims in an application, ***even though they are directed to distinct inventions***, unless to do so would create a serious burden. In the instant case, this invention pertains to the discovery that nuclear transcription factor ligands can modulate estrogen activation at an AP-1 site. Accordingly the claims of Group I are drawn to methods of screening nuclear transcription factor ligands for this property, while the claims of Group II are directed to methods of screening for agents that modulate the ability of a transcription factor ligand to alter this modulation and the claims of Group III are directed to kits for practicing these methods. A search for art relevant to nuclear transcription factor ligand modulation of estrogen activation at an AP-1 site is expected to identify any prior art, if it exists, relevant to the assays of Groups I and II and to the kits of Group III. Accordingly a search for art relevant to all three groups entails no greater burden than a search for art relevant to Group I. Examination of all three groups together thus entails no serious burden and, in accordance with MPEP §803 the restriction requirement between Groups I, II, and III should be withdrawn.

In view of the foregoing, Applicant believes all claims now pending in this application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

If a telephone conference would expedite prosecution of this application, the Examiner is invited to telephone the undersigned at (415) 248-5500.

Dated: January 12, 2000.

Respectfully submitted,



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Tom Hunter, Reg. No: 38,498

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